IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Christopher J. Dyl	Art Unit	: 3714
Serial No.	: 10/633,062	Examiner	: Frank M. Leiva
Filed	: August 1, 2003	Conf. No.	: 3611
Title	: Securing goal-activated game content		

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005 - New Pre-Appeal Brief Conference Pilot Program, a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. Review of these identified matters by a panel of examiners is requested because the rejections of record are clearly not proper and are without basis, in view of a clear legal or factual deficiency in the rejections. All rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved.

Applicant's disclosure

When playing an online game, a player is often confronted with certain challenges. If the player completes a challenge, the player's client machine tells the server about it. The server then sends certain "goal-activated content" back to the client. For a limited period, the player enjoys this goal-activated content. Once the limited period expires, the player is barred from accessing the content.

In prior-art online gaming systems, even though the player is barred from accessing the content, the content itself remains at the client. Thus, a knowledgeable hacker could in principle access the goal-activated content even after the lapse of the limited period.

Applicant has overcome this flaw by having the server actually instruct the client to delete the goal activated content. This is recited in claim 1, as "at a server, ... instructing the first client to delete the goal-activated content stored on the first client."

A "bet" is a contract, not a "challenge"

In *Walker*, a shopper selects a prize and pays an entry fee to participate in a lottery. If the shopper wins the lottery, he receives the prize. If the shopper loses, the fee is applied as a discount to a future purchase.

The Examiner begins by saying that claim 1 doesn't refer to a "game challenge." This is incorrect. Claim 1 as amended in the preceding response requires "receiving information indicating that a first player ... has completed a game challenge."

Next, the Examiner explains what "challenge" means. Specifically, the Examiner says that when you say "I'll bet you $5 the Knicks will win," you've made a challenge. When someone accepts this bet, he accepts your challenge. Based on this semantic theory, the Examiner says that buying a lottery ticket is really no different from accepting a challenge.

Applicant believes the Examiner's theory is flawed because it would apply to all sorts of purchases that nobody would ever seriously regard as "challenges." For instance, if you buy medical insurance, the insurer is really "betting" that you will not get sick any time soon. Under the Examiner's theory, the insurer is "challenging" you to not get sick, and you accept this challenge by paying the premium. But nobody would seriously call this a "challenge." The insurer is obviously not "challenging" you to get sick any more than *Walker*'s lottery vendor is "challenging" you to win a lottery.

The flaw in the Examiner's logic is even more apparent when one begin to ask questions like "who is being challenged" and "who does the challenging." The Examiner's theory seems to be that in *Walker*, the lottery vendor challenged the shopper to win the lottery, and the shopper accepted the challenge by buying a ticket. But you could just as easily have said the opposite: the shopper challenged the lottery vendor to a lottery, and the lottery vendor accepted by selling the ticket. There is really no logical reason to prefer one over the other.

In a real challenge, as those of ordinary skill in the art would understand the word, you would have no trouble easily identifying who is being challenged, and who is doing the challenging. In contrast, under the Examiner's theory, which says that "betting" and "challenging" amount to the same thing, you can't really tell who is doing the

challenging. There's a very good reason you can't tell. It's because one of ordinary skill in the art would never call entering a lottery a "challenge."

What the Examiner describes as a "challenge" is really just contract formation, with each side promising to pay the other $5 depending on whether or not the Knicks win. Entering into a contract does not amount to issuing or accepting a challenge.

The allegedly challenged party in Walker has no task to accomplish

Another reason why entering *Walker*'s lottery is not a "challenge" is that the challenger has no particular task to accomplish. In a real challenge, the challenger sets forth a task, and the challenged party agrees to undertake the task. The outcome of the challenge depends on whether the challenged party completes the task.

In *Walker*, the challenged party, i.e. the shopper, has no particular "task" to carry out as a condition for claiming his prize.

The task is certainly not paying the entry fee. According to the examiner, that's how the shopper accepts the challenge. The task certainly isn't choosing the winning number. After all, the shopper doesn't actually do that. He just pays an entry fee and waits for an outcome. Aside from paying an entry fee and waiting for the outcome, there really isn't very much else for the challenged party to do. Thus, there is no way in *Walker* for anybody to receive "information indicating that" the shopper "has completed a game challenge" for the simple reason that the shopper really has nothing to do.

Applicant recognizes that the Examiner is entitled to the "broadest reasonable interpretation" of a claim. But that interpretation is constrained by what one of ordinary skill in the art would understand from the specification. The idea that buying a lottery ticket amounts to accepting a challenge does not comport at all with how one of ordinary skill in the art would understand the claim. Accordingly, the Examiner's interpretation of a "game challenge" as including the purchase or sale of a lottery ticket is clear legal and/or factual error.

The transaction in *Walker* is not really a "bet"

Even if one were to subscribe to the notion that a "bet" is a "challenge," the transaction described in *Walker* is not really a "bet." One of ordinary skill in the art would have understood that in a real "bet," it is possible to lose.

In the transaction *Walker* describes, the shopper who pays the entry fee cannot lose. The only two outcomes are that he receives his prize, or his entry fee is awarded as a credit on a purchase. He can never actually lose his entry fee. Accordingly, the transaction Walker describes cannot properly be regarded as a "bet."

Motivation to combine references is flawed

According to the examiner, in *Walker*, the prize can be multi-media content that is transmitted to the shopper's computer. The Examiner then asserts that one of ordinary skill in the art would have found it obvious to later reach into the shopper's computer to snatch away his prize. The Examiner says that one of ordinary skill in the art would have known that multi-media is the subject of copyright and that it therefore has a "limited shelf life."

The Examiner's logic makes no sense. One of ordinary skill in the art would have understood that when you acquire copyrighted music for your computer, the copyright tells you not to copy the music until the copyright term expires. It does not tell you to discard the copyrighted music when the copyright expires.

One of ordinary skill in the art would have learned from *Nakano* that in some cases, one who receives copyrighted material would be bound by contract to delete it after some limited time. But one of ordinary skill in the art would have had no reason to believe that a prize won in a lottery with *Walker*'s system would be subject to the rather specialized contract terms as set forth in *Nakano*. In the ordinary course of events, when one buys a book, a CD, or any other copyrighted material, the reasonable expectation is that it is yours to keep. Thus, absent any evidence to the contrary, one of ordinary skill in the art would have regarded the *Walker* prize winner's reasonable expectation to be that his prize was his to keep forever.

The notice of appeal fee in the amount of $270 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account

authorization. Please apply all charges or credits to Deposit Account No. 50-4189, referencing Attorney Docket No. 30064-015001.

Respectfully submitted,

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Faustino A. Lichauco
Reg. No. 41,942

Customer No. 69713
Occhiuti Rohlicek & Tsao LLP
10 Fawcett Street
Cambridge, MA 02138
Telephone: (617) 500-2533
Facsimile: (617) 500-2499